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Kazuhisa Mukai

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BROWDY AND NEIMARK, P.L.L.C.
624 NINTH STREET, NW
SUITE 300
WASHINGTON, DC 20001-5303

EXAMINER

BARNHART, LORA ELIZABETH

ART UNIT

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1651

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Continuation Sheet for Advisory Action

Continuation of Box 3. The proposed amendments will not be entered because they introduce new limitations that require more than a cursory consideration by the examiner. The proposed “DE of less than 10” limitation is not recited in the specification, and the working examples do not cover this entire range. Given that the art indicates that different starches have different properties, the range would require thorough examination for support in the specification and for art issues. See final rejection, pages 6-7.

Continuation of Box 11. The request for reconsideration has been fully considered, but it does NOT place the application in condition for allowance because it is not drawn to claims currently under consideration.

The proposed claims appear to further prosecution, but for the reasons above, they do not clearly overcome the art rejections. Applicant’s arguments throughout prosecution have been based on the fact that the enzyme employed in the instant method has special properties that are not expected to be possessed by enzymes from other sources (such as the intestine RIAGase of Yamamoto). Applicant cannot argue on one hand that the enzyme has unexpected properties, then argue that the properties would be expected to be present outside the exemplified embodiments.

Furthermore, the remarks after final rejection do not properly address the issue of the breadth of *Arthrobacter* species that might yield the enzyme of the instant method. The remarks on this point rely largely on a WO publication that has never been cited by

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the examiner or on an IDS; furthermore, applicants did not furnish a copy of this WO publication with the instant reply. Even if applicants had supplied a copy of the WO publication with the 4/21/10 reply, which they have not, it would not have been a timely submission. The examiner commented on the narrow showing in the Nishimoto declaration on the subject of the enzyme's source in the final rejection mailed 3/12/09 (see page 6), so it is not an issue that was raised for the first time in the 1/27/10 final rejection. Since the source of the RIAGase has been the central issue throughout prosecution, applicants have had ample opportunity to supply evidence as to the possible sources of the critical enzyme.

/Lora E Barnhart/
Primary Examiner, Art Unit 1651